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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/352,192 07/12/99 HILL

J DYN-6D1-1

J
MM42/1006
JAMES W POTTHAST
POTTHAST & RING
HARBOR HOUSE SUITE 100
3200 N LAKE SHORE DRIVE
CHICAGO IL 60657

EXAMINER

LEE, M

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 10/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☐ Responsive to communication(s) filed on _____☐ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-3 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.☒ Claim(s) 1-3 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____☐ Interview Summary, PTO-413☒ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

Part III DETAILED ACTION

1. Acknowledgment is made that this application is a divisional of Application Serial No. 08/647,158 filed 09 May 1996, which issued as U.S. Patent No. 5,923,015, which is a divisional of Application Serial No. 08/036,664 filed 24 March 1993, which issued as U.S. Patent No. 5,388,815, which is a continuation-in-part of Application Serial No. 08/019,865 filed 19 February 1993, now abandoned.

Double Patenting

2. Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 12-13 of U.S. Patent No. 5,494,544 (assigned to Mr. Jeffrey L. Hill et al, hereinafter '544). Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 1-3 of the instant application, Applicants claim a method of verifying and validating the embossed information read from the embossed card to the prestored card information prior to insertion of the embossed cards into the card carrying mailing forms, etc.. The method of performing the above claimed invention is recited in claims 1-3 and 12-13 of '544 patent. Although, the only difference between the present claimed invention and of the '544 patent is the utilization of different terminologies and/or rephrasing of the terminologies, etc., the Examiner believes that the scope of claims 1-3 of the present application and claims 1-3 and 12-13 of '544 patent are almost identical but differ only in terminology and/or the way the terminologies have been rephrased. Moreover, the Examiner believes that the instant claim is obviously encompassed by the patented claims of '544 patent.

Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to utilized the teachings of claims 1-3 and 12-13 of '544 patent to modify the method of performing the packaging of the embossed cards to perform the same functions, and to utilized the same terminologies as claimed by the present application. To the extent that

1 the instant claims are broaden and therefore generic to the claimed invention of '544 Patent [species], In re
2 Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal
3 disclaimer, if a species claim has been previously been claimed in a co-pending application.

4 The obviousness-type double patenting rejection is a judicially established doctrine based upon
5 public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a
6 second patent not patentably distinct from claims in a first patent. *In re Vogel*, 164 USPQ 619 (CCPA
7 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an
8 actual or provisional rejection on this ground provided the conflicting application or patent is shown to be
9 commonly owned with this application. See 37 C.F.R. § 1.78(d).

10
11 ***Claim Rejections - 35 USC § 102***

12 3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis
13 for the rejections under this section made in this Office action:

14 A person shall be entitled to a patent unless --

15 (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale
16 in this country, more than one year prior to the date of application for patent in the United States.

17 4. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Hill et al (US 4,034,210).

18 Hill et al teaches a system and method for processing a plurality of credit card carriers 1
19 comprising a bar code reader/optical reader [95, 159] (see col. 17, lines 19+; and col. 20, lines 50+) for
20 reading from the carrier the carrier information 24b printed thereon (e.g., a plurality of different standard
21 codes/any type of bar codes (see col. 10, lines 43+; and col. 12, lines 16+), such as, I-bar code, OCR,
22 mag code, delta distance code, etc.); logic and command module (LCM) 97 (see col. 17, lines 27+) (i.e.,
23 means for comparing) for comparing the carrier information read from the carrier with the stored carrier
24 information to determine if there is a match with respect to the embossed plastic card(s); means responsive

1 to the comparing means for automatically identifying each carrier for which the carrier information printed
2 on the carrier does not match the stored carrier information for the carrier with respect to the embossed
3 plastic card(s); and the LCM includes the means for automatically rejecting identified non-matching
4 carriers to prevent insertion of the embossed plastic cards into non-matching carriers. See also figures 1-
5 4; col. 10, lines 40+; col. 12, lines 9-60; col. 13, line 35 through col. 14, line 51; and col. 17, lines 27+.

6
7 *Conclusion*

8 5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hill
9 et al (US 4,194,685), Hill et al (US 5,388,815), Hill et al (US 5,923,015), LaManna et al (US 4,088,216),
10 LaManna et al (US 4,969,760), Bobart et al (US 4,349,741), and Fujioka (US 5,151,582) discloses a system
11 and method of authenticating a medium having a magnetic stripe, IC module, embossed characters, etc..

12 6. Any inquiry concerning this communication or earlier communications from the examiner should be
13 directed to **Michael G. Lee** whose telephone number is (703) 305-3503. The examiner can normally be
14 reached between the hours of 6:30AM to 4:00PM Monday thru Thursday and every other Friday (first Friday
15 of the bi-week).

16 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald T.
17 Hajec, can be reached on (703) 308-4075. The fax phone number for this Group is (703)308-5841 or (703)
18 308-7722.

19 Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132
20 or which otherwise require a signature, may be used by the applicant and should be addressed to
21 [michael.lee@uspto.gov].

22 *All Internet e-mail communications will be made of record in the application file. PTO employees*
23 *do not engage in Internet communications where there exists a possibility that sensitive information could*
24 *be identified or exchanged unless the record includes a properly signed express waiver of the*
25 *confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage*

Serial Number: 09/352,192

Applicant(s): Jeffery L. HILL et al (235,380)

Page 5

Art Unit: 2876

Representative: James W. Potthast (26,792)

1 *Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG*
2 *89.*

3 Any inquiry of a general nature or relating to the status of this application or proceeding should be
4 directed to the Group receptionist whose telephone number is (703) 308-0956.



Michael G Lee
Primary Examiner

SEPTEMBER 21, 1999
Technology Center 2800